



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,108	08/10/2000	Erik M. Theisen	GLNPIN114873	6358

7590 06/02/2005

CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC
Suite 2800
1420 Fifth Avenue
Seattle, WA 98101

EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/636,108

Applicant(s)

THEISEN ET AL.

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,8-10,15,16,22,24-26,31 and 32 is/are allowed.
- 6) ☒ Claim(s) 1-5,7,11-14,17-21,23,27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “a past or future supervisory signal” (line 10) is not clearly defined. It is unclear the claimed refers to a singular signal or two signals (meaning “a past supervisory signal or a future supervisory signal”).

Allowable Subject Matter

2. Claims 6, 8-10, 15-16, 22, 24-26, 31-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See reasons for allowable subject matter in previous Office Action mailed on 8-13-04.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5, 7, 11, 12, 14, 17-19, 21, 23, 27, 28, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertocci (US: 5953656), and in view of AT&T Answering System 1721 Owner's Manual and further in view of Chamberlin (US: 4309571).

Regarding claims 1, 17, Bertocci teaches on Fig. 1 and Fig. 2 a portable handset and a base unit with TAD (the TAD of Bertocci reads on the claimed VMS) circuits.

Bertocci teaches on column 10 line 32-42 the TAD control functions, including playing message, can be entered from the keypad of the handset (Note: Bertocci's handset is a cordless telephone which reads on the claimed telephone). It is inherent that the keypad generates a "start" command to activate the "play message" feature.

Bertocci fails to explicitly teach a "stop" command is generated from the handset for stopping the "play message" feature. However, using telephone keypad to generate control signal for remotely stopping the playing feature of an answering machine was old and well known feature. The Owner's Manual of AT&T Answering System 1721 teaches that a remote caller can press "#" from his telephone to stop the message playback of the remote answering machine (see

Art Unit: 2645

page 13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Bertocci such that the handset user can generate a “stop” command from the handset to stop the message playback in the base unit. The modification frees the handset user to hear the entire message.

Bertocci further fails to teach “providing feedback to the user via a supervisory signal during repositioning”. In other words, Bertocci does not teach that a display is used to show the progress of repositioning during playing of a message in the base unit. However, Chamberlin teaches on column 4 line 12-40 a telephone answering device and/or dictation unit with index, or cursor indication, or LED, or LCD to indicate the repositioning. Chamberlin further teaches a display (unit 24, Fig. 1) has cursor for indicating the movement of the tape when the tape is advanced from one end toward the other. The “index, or cursor indication, or LED, or LCD” is not an integral part of the voice message. Further, as Bertocci teaches on column 3 line 14-20, the TAD records multiple messages for the user to access. Therefore, the supervisory signal provided for each message is discrete from supervisory signals for past and future messages (reads on claimed “past or future supervisory signals”). Also, the LED or LCD as taught by Chamberlin on column 4 line 12-40 changes along with the message repositioning. The LED or LCD must receive discrete signals for the LED or LCD changes. Every change signal is discrete from past or future signal.

Since using indicator to indicate the position of a message or a tape is very old and well known and such indicator was widely used in “playback” feature, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Bertocci as modified by the AT&T Owner’s Manual above and further to have a display as taught by

Art Unit: 2645

Chamberlin in the base unit of Bertocci such that the user of Bertocci can know how far the message has been announced during the “playback” of a message. Such modification further provides additional information to the user to realize how much memory space has been used.

Regarding claims 2, 18, Bertocci teaches that the TAD commands for “playing message” are entered via the keypad.

Regarding claims 3 & 19, the modified Bertocci as stated in the rejections for claim 1 & 17 above inherently has the claimed keyed “stop” command (see page 13, “#” of AT&T Answering System 1721 Owner’s Manual).

Regarding claims 5, 21, the modified Bertocci as stated in the rejections for claims 1 & 17 above inherently has the claimed limitation because the LCD, LED or the cursor (see col. 4 lines 25-28 of Chamberlin) are the claimed visual signal.

Regarding claims 14, 30, the modified system of Bertocci in view of AT&T Answering System 1721 Owner’s Manual, and Chamberlin as stated in claim 1 above failed to teach “the repositioning comprises rewinding”. However, this feature is very old and common. See page 13, left column, the “2” command teaches the “rewinding” feature. Thus, it would be obvious to further modify Bertocci to allow the handset user to remote activate the rewinding feature of the base unit. The modification gives additional control feature, i.e., remote control to the handset user such that the user does not need to always next to the TAD.

Regarding claim 7 & 23, Chamberlin displays the indicator by LED and LCD during the whole (fix) interval of playback.

Regarding claims 11 & 27, "fast forward". See page 13, the skip message command.

Regarding claims 12 & 28, the Manual teaches the "skip" control command which is obvious to provide in the handset of Bertocci for freeing the user to hear the entire message.

4. Claims 4, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertocci (US: 5953656), and in view of AT&T Answering System 1721 Owner's Manual, and Chamberlin, and further in view of Rosen et al (US: 5784436).

Bertocci in view of AT&T Answering System 1721 Owner's Manual and Chamberlin as stated in claim 1 above failed to teach "the supervisory signal is an aural signal". However, Rosen et al teach on column 1 line 22-24 a warning beep (claimed "aural signal") to indicate the conversation is being recorded.

It would have been obvious to one skilled at the time the invention was made to modify Bertocci, AT&T Answering System 1721 Owner's Manual, Chamberlin to have aural signals as taught by Rosen et al such that the modified system of Bertocci, AT&T Answering System 1721 Owner's Manual, Chamberlin would be able to comply with the law to inform the other party of the call that the conversation is being recorded.

Art Unit: 2645

5. Claims 13, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertocci (US: 5953656), and in view of AT&T Answering System 1721 Owner's Manual, Chamberlin, Ireton (US: 5970447).

Bertocci in view of AT&T Answering System 1721 Owner's Manual, Chamberlin, as stated in claims 12 and 28 above failed to teach "providing a signal that the end of the message has been reached". However, the end of message signal were very old in the art of telephone answering machine. For example Ireton teaches on column 1 line 21-23 that the end of message signal is used to enable the TAD to detect the end of message. Thus, it would have been obvious to one skilled at the time the invention was made to modify Bertocci, AT&T Answering System 1721 Owner's Manual, Chamberlin, and further modify Bertocci's TAD to generate the end of message signal as taught by Ireton such that the TAD of Bertocci can immediate detect the end of the message such that the TAD can stop the playback feature – a way of prevent overload the TAD.

6. Claims 1 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilcox et al (US: 6404856), and in view of Greco et al (US: 5568540).

Wilcox teaches a telephone (see Fig. 2 and col. 4 line 9-11) with a voice message system (see Fig. 1, 3 and col. 3 line 41-42, col. 5 line 65 – col. 6 line 6). Wilcox teaches that an audio bar (col. 2 line 62) is used to show the progress of an incoming message during a recording mode (col. 4 line 35-42). Wilcox further teaches that the recorded message can be retrieved for playback (col. 6 line 31-53) by using the telephone (Note, the start/stop playback commands are generated by pressing the buttons on Fig. 3 which is on the telephone as shown in Fig. 2). What

Art Unit: 2645

Wilcox fails to show is that the audio bar is used to show the position of a recorded message during the message is in playback mode. However, Greco at Fig. 3 shows that an audio time line bar is used as a progress indicator during a message playback mode (col. 5 line 50-55). Further, the benefit of using the timeline bar is obvious. The person who hears the message knows how long is the message such that he may terminate a long message. Therefore, it would be obvious to modify Wilcox such that when a message is being announced, the audio bar as taught by Greco will be used to show the "repositioning" information.

Response to Arguments

7. Applicant's arguments filed on 2/7/05 have been fully considered but they are not persuasive.

- i) Applicant argues, on page 8, regarding new amendments. New grounds of rejections necessitated by the amendments have been stated above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (571) 272-7535. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600. Any response to this action should be mailed to:

Application/Control Number: 09/636,108

Page 10

Art Unit: 2645

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

